

REMARKS

Applicants have read and considered the final Office Action mailed October 20, 2008. Applicants have amended claims 1, 25 and 49. Claims 1-12, 14, 17-36, 38, 41-59 and 63-68 remain pending.

Independent claims 1, 25 and 49 have been amended and clarify the server-based aspect of the signing of an electronic document through a web browser according to the present invention. No new matter has been added to the application through these modifications.

In the Office Action, previous independent claims 1, 25 and 49 were rejected under 35 U.S.C. § 103(a) as being obvious over the teachings of Smithies et al. (U.S. patent No. 6,091,835) in view of Davis et al. (U.S. patent No. 7,209,571) and further in view of Romney et al. (U.S. patent No. 6,085,322).

Applicants assert that amended claim 1 is not obvious over the teachings of the cited reference, for the following reasons.

Generally speaking, the method of claim 1 provides for the application of a legally enforceable signature on an electronic document in a web environment. The electronic document is located on a server, and the user interacts with the web environment through a web browser. The server has a plurality of modules that control the presentation of the document to the user, the signing ceremony and the logging processes. This method advantageously allows the user to perform the signing ceremony through the sole use of this web browser, without the need for any special software to be installed on the user's computer system. The intent of the signer, and hence the legal agreement, can be reproduced at a later time since what was presented to the user through the browser and their actions in moving from one web page to another has been recorded into a process log that allows reconstruction of the actual presentation of the web pages to the user, including the contents of the documents and the actions taken in moving from one web page to another while reviewing the document. The various features of claim 1 collaborate together to attain this objective.

The first step of this method, step a), involves having the user access the web environment from a secure electronic system that verifies the identity of the user. Claim 1 has been slightly modified to specify that the user accesses the web environment through a web browser, as explained in the description. The secure electronic system may, for example, be embodied by a website where the user is already a member. This website therefore stores

information that is unique about the user in the context of that website, and which can be used to identify and authenticate the user. The website may, for example, be an e-commerce server, or the like. The method of claim 1 assumes that this website or other secure system has already identified the user before engaging in the signing ceremony.

The Office Action asserts that the step of having the user access the web environment from a secure electronic system, said secure system having already verified the identity of the user, is known from Smithies, Col. 12, lines 28 to 54. However, nowhere in the cited passage is there any mention of accessing a web environment through a secure electronic system. In fact, it would be irrelevant to provide such an access in the embodiment considered in this passage of Smithies, and indeed, most of the embodiments described by Smithies, since the software described by Smithies resides on the user's computer system, and is not accessed through a web environment. It is also to be noted that in the one web embodiment of Smithies, described at Cols. 41 and 42 of the description of this patent, the process of identifying the user requires for an interface program (for example, a Java applet) to be downloaded on the user's computer system. This interface program then captures the day, time and time zone of the affirming party's local computer system, and then presents this information in a composite window for the affirming party to either accept or reject the data. The interface program is then invoked again, to request personalization data from the affirming party, and to transmit all of the affirming party's interactions until the composite window is dismissed. (See Col. 42, lines 37 to 52). All these interactions require additional programming of the user's computer system, and could not be accomplished through a simple web browser. It therefore cannot be said that Smithies teaches the step of a user accessing a web environment through a web browser having verified the identity of the user.

Claim 1 of the present application next recites a step of having the user sign the electronic document in the web environment. This entire signing ceremony is server-based, that is, the substeps of step b) are performed by the modules on the server. The first substep of this signing, bi), involves presenting the user with a web-based representation of the document in the web browser. As explained in the specification, in practice this may for example be realized by a merchant e-commerce website performing a hand-off to the e-Signing Process (the server) and providing all pertinent data and information needed to generate the appropriate contract for

approval and signature. It is therefore the server managing the signing ceremony that presents the document through a web browser to the user, not the merchant or other system or application.

The Office Action refers to Smithies, Col. 42, lines 8-24, to argue that this step is known from the prior art. However, in this passage of Smithies the presentation of webpages to the affirming party and the signing ceremony are described as two different processes performed by different systems. The information concerning the form to sign is presented to the affirming party by the Web Server (see Col. 42 line 22), whereas the interactions with the affirming party constituting the signing ceremony are managed by the transcript generator module (Col. 42 lines 32 to 36).

The next substep of claim 1, bii), involves presenting the user with legal information related to the signing, and obtaining the user's agreement with this information in the web browser. The Office Action relies on Smithies, Col. 34, lines 8-17 to argue that such a step is known through the prior art. However, while this passage refers to the presenting of information related to a legal issue (legal accountability) to an affirming party, it does not suggest that this should be done through a web browser, nor that interaction with this web browser should be used to obtain the agreement of a user of legal information. In the embodiments described in the specification of the present application, this is achieved, for example, by providing "I AGREE" buttons or equivalents in the relevant webpages. As the particular embodiment described in the cited passage of Smithies is not carried out in a web environment, the use of a web browser in this context cannot be inferred from this passage. In the one web embodiment of Smithies, Cols. 41-42, the presenting and agreement of legal information is not mentioned. Again, Applicants note that in the web embodiment of Smithies, an interface program is installed on the user's computer system to interact with the affirming party, and Smithies does not rely on the web pages presented to the user containing the form to interact with him and create the signing ceremony. It therefore cannot be said that Smithies teaches a step of "presenting the user with legal information related to said signing, and getting agreement from the user of said legal information in said web browser".

In substep biii) of claim 1, upon obtaining the signing command and agreement of the legal information from the user, the signature of the user is applied to the document on the server. The Office Action relies on Col. 34 line 61 to Col. 35 line 49 of Smithies to demonstrate that this step is known. However, the cited passage does not mention the actual application of

the signature on the document, nor that this document resides on a server. The server-related aspect of this feature of claim 1 is irrelevant to the embodiment of the cited passage of Smithies as it does not take place over the web. In the one web embodiment of Smithies, the document does not reside on the server performing the signing ceremony. The document is a web form presented to the affirming party by a different entity than the transcript generator module managing the signing ceremony, and the signature is never sent to this entity, and therefore cannot be applied to the document at all. It therefore cannot be said that Smithies teaches all the features of substep biii).

The next step of claim 1, step c), involves generating a process log of the signing of step b) on the server, this process log comprising a record of the substeps bi) to biii) as executed, and allowing a reconstruction of the web-based representation of the document and of the legal information as presented to the user through the web browser. The Office Action asserts that the following is known from the cited prior art:

“(...) transcript object recreates the documents and all actions during the signing procedure to the user for final approval of the signature and document (Smithies, column 42, lines 32-52)” [Office Action page 7, first paragraph, emphasis added]

What is actually said at Col. 42 lines 32-57 of Smithies is that the transcript object stores all the interactions between the affirming party and a small window generated by the interface program invoked by the transcript generator module. However, these interactions cannot include the web-based representation of the document being affirmed as presented to the user, since this document is never presented in the window in question. The presenting of the document (form) being affirmed is in fact performed by the website embodying the client application, not by the transcript generator module (Smithies, col. 42, lines 22-30). The transcript generator module cannot therefore keep a record of the step of “presenting the user with a web-based representation of the document in said web browser”, as it is not involved in this step, and does not possess the relevant information. This makes sense in the context of the invention of Smithies, since the transcript generator module of Smithies is designed to be as independent as possible from the object being affirmed, in order to preserve versatility. In this manner, the transcript generator module can be used in conjunction with a variety of client applications such as word processing programs, spreadsheet programs, or specialized software to perform or record the occurrence of an event in which the affirming party participates (see Col. 12, lines 3-27). In

addition, Smithies does not consider having a same entity (the server) handle the presentation of the document to be affirmed, the steps of the signing ceremony and the generation of the process log as it promotes the segregation of these duties among different components as a measure to prevent forgery (see Col. 9 lines 45-54).

It is important to note that in the method of claim 1, the interaction with the user is recorded indirectly; only the webpages presented to the user, that include the web-based representation of the document to be signed, need to be included in the process log, and the record of the signing ceremony follows from the contents and logic of the presentation of these webpages. In other words, the fact that the user saw a particular webpage signifies that he clicked on the appropriate button, and therefore gave the signing command or indicated his approval of the legal information presented in a previous webpage: the content of each webpage presented to the user, and the order thereof, tells the story. This allows for the process log to evidence the signing ceremony without the need to interact directly with the user's computer system, for example, through an interface program such as the Java applet of the web embodiment of Smithies. It also provides an elegant manner of keeping a full record of the transaction without having to record every interaction of the affirming party with the system, as is the case in Smithies.

It is further argued that Smithies is representative of the general view of those skilled in the art prior to the present invention. In order to provide a proper record of the signing ceremony of a document online, the state of the art required collecting data related to the interaction of the user with the signing software while the viewing of the document, transaction or event being affirmed is controlled separately from signing software. The invention of claim 1 therefore presents a significant departure from this view, as it relies on the logic of the webpages presented to the user that include the document or information being affirmed or signed to provide a record of the signing ceremony. The contents of this record therefore reveal the entire information that was presented to the user, and not just what the user did in response to this information. This approach is important in a web environment since a server and any associated logic or programming presents requested web pages by creating them only as required for a particular user at a given moment and does not store those particular pages as presented as a single record. Therefore reproducing exactly the web page as presented to the particular user at that time is

extremely difficult if not near impossible. Neither Smithies nor the other cited art teach or suggest this strategy.

It is submitted that, contrary to the arguments of the Office Action, steps b) and c) as presently formulated are not fully known from Smithies, and that there are therefore significant differences between the prior art and the claims at issue, as per the analysis set forth in *Graham v. John Deere*. The comments in the "Response to Arguments" at page 2 of the Office Action are considered moot, since it has clearly been demonstrated above that Smithies does not teach all of the elements of claim 1. This is in stark contrast with the cited case of *In Re Keller*, where the Appellant did not argue that any features of the rejected claims other than the ones at issue were not disclosed in the cited prior art. Moreover, Davis and Romney fail to address the shortcomings of Smithies. The combination of Smithies, Davis and Romney therefore cannot be said to lead one skilled in the art to the teachings of claim 1 as a whole.

As independent claims 25 and 49 include similar limitations to those of claim 1, they are considered patentable on the same grounds. All other claims are dependent on either one of independent claims 1, 25 and 49, and rejection thereof is considered moot.

If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

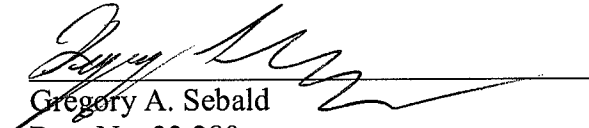
Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725.

Respectfully submitted,

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